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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,757	09/17/2001	Katsuhiko Kumakura	10059-397US (P22089-03)	8993
570	7590	07/08/2004	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,757

Applicant(s)

KUMAKURA ET AL. *On*

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7, 14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action acknowledges the applicant's amendment submitted 27 April 2004. Claims 1, 2, 4-7, and 14-18 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The replacement drawings filed 30 July 2003 are acceptable.

Claim Rejections - 35 USC § 103

4. Claims 1, 2, 4, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz Gerald (US 1,272,411) in view of Novak (US 2,299,027) and Worley (US 4,971,197).

Regarding claims 1, 2, and 16, Fitz Gerald discloses a tubular case (2, 3, 4, 5); an opening (as shown, Figure 1); a lid (6, 7); a bottom (10); and an inclined extracting outlet (opening formed by the bending of flaps 14 and 15). The case of Fitz Gerald is capable of functioning as claimed by the applicant and meets all limitations claimed by the applicant except:

Fitz Gerald does not disclose a "square" tubular case or unit packages containing a plurality of stick-like articles.

Worley teaches that it was known in the art to place plural batteries (i.e. stick-like articles) in a unit package. Novak teaches that it was known in the art to provide stacked batteries in a square-tubular dispensing case aligned in parallel with the front wall of the case. The case of Fitz Gerald is general in nature and capable of dispensing a variety of products. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the case of Fitz Gerald with a square shape in order to accommodate the shape of the product contained. A change in shape has been generally recognized as being within the level of ordinary skill in the art. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide unit packages of batteries in the container of Fitz Gerald as taught by Worley and Novak in order to present the batteries for consumer purchase.

As to claim 4, Fitz Gerald discloses bottom surface (9).

Regarding claim 18, the case of Fitz Gerald-Novak-Worley, as applied to claim 16 above, discloses the claimed invention except for the extracting outlet that extends to portions of the front and rear walls.

Novak teaches the extracting outlet having an opening that extends to portions of the adjacent walls in order to facilitate gripping of the article for extraction (see Figure 2 and Col. 4, lines 3-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Fitz Gerald-Novak-Worley with an extracting outlet extending to portions of the front and rear wall as taught by Novak in order to facilitate gripping of the article for extraction.

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5. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz Gerald in view of Worley and Novak as applied to claim 1 above, and further in view of Carlson et al (US 5,460,322).

Regarding claim 5, the dispensing package of Fitz Gerald-Worley-Novak meets all limitations claimed by the applicant except for a suspending piece.

Carlson et al discloses a square tubular dispensing package (Figures 7-9) with a suspending piece (40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the dispensing package of Fitz Gerald-Worley-Novak with a suspending piece as taught by Carlson et al for the obvious reason of hanging the dispensing package from a rod commonly used in retail store displays.

Regarding claim 14, the dispensing package of Fitz Gerald-Worley-Novak discloses a dispensing package assembled by a single sheet (Fitz Gerald, Figure 5) having a front wall (2), a rear wall (3), a right side (4), a left side (5), flaps (6) and top wall (7), and bottom wall (9); and a separate base (Fitz Gerald, Figure 6, items 10, 11, 12, 13) including a top surface (10) which is inclined (as shown, Fitz Gerald, Figure 2). The package of Fitz Gerald-Worley-Novak meets all limitations claimed by the applicant except for a tear-off portion for forming the extracting outlet.

Carlson et al discloses a square tubular dispensing package (Figures 7-9) with a tear-off portion (50) for forming the extracting outlet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the dispensing package of Fitz Gerald-Worley-Novak with a tear-off portion for forming the extracting

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outlet as taught by Carlson et al in order to maintain a sealed container until the presentation to the consumer. The examiner notes that tear-off portions are common and conventional in the dispensing carton art.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz Gerald in view of Worley and Novak as applied to claim 1 above, and further in view of Weiss (US 5,836,478).

The dispensing package of Fitz Gerald-Worley-Novak meets all limitations claimed by the applicant except for at least a front wall being transparent.

Weiss discloses a dispensing package (10) with transparent walls (Col. 2, ll. 50-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the dispensing package of Fitz Gerald-Worley-Novak with transparent walls in order to enable the visual inspection of the contents.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz Gerald in view of Worley and Novak as applied to claim 1 above, and further in view of Klein, Sr. (US 3,927,809).

The dispensing package of Fitz Gerald-Worley-Novak meets all limitations claimed by the applicant except for a partition.

Klein, Sr. discloses a dispensing package (Figures 4 and 5) with a partition (C'). Klein, Sr. teaches the partition for separating used and unused components in the same container (Col. 2, ll. 25-39). It would have been obvious to one of ordinary skill in the art

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at the time the invention was made to provide the dispensing package of Fitz Gerald-Worley-Novak with a partition as taught by Klein Sr. in order to distinguish between the used and unused batteries while maintaining a single container for disposal and transport.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz Gerald.

Fitz Gerald discloses a tubular case (2, 3, 4, 5) having sidewalls (4, 5) and a bottom (10, 11, 12, 13), the bottom having an inclined top surface (10); an opening (as shown, Figure 1); a lid (6, 7); and an inclined extracting outlet (opening formed by the bending of flaps 14 and 15). The case of Fitz Gerald is capable of functioning as claimed by the applicant and meets all limitations claimed by the applicant except:

Fitz Gerald does not disclose a "square" tubular case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the case of Fitz Gerald with a square shape in order to accommodate the shape of the product contained. Such a modification would be an obvious matter of design choice.

Allowable Subject Matter

9. Claim 15 is allowed.

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10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

11. Applicant's arguments filed 27 April 2004 have been fully considered but they are not persuasive.

12. In response to the applicant's argument that the cutout created by flap 14 is not large enough to dispense articles, the examiner notes that there is no specific size claimed for the stick-like articles. The cutout created by flap 14 is capable of dispensing articles depending upon the size of those retained.

13. In response to the applicant's argument that the lip (13) and shelf (16) of Fitz Gerald would prevent the dispensing of batteries, the examiner asserts that the package of Fitz Gerald, as modified with the square shape of Novak, would have been capable of dispensing the unit packages denoted as item (12) in Figure 3 of Worley (see for example, Fitz Gerald lines 79-89).

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The motivation for dispensing batteries can be found in Novak.

15. In response to the applicant's arguments concerning claim 17, the examiner notes that no product is claimed and that the package of Fitz Gerald need only be capable of functioning as claimed. The opening created by flap (14) is capable of allowing the passage of articles. Further, a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory Pickett
Examiner
July 6, 2004



JILA M. MOHANDESI
PRIMARY EXAMINER